

REMARKS

Claims 3-5, 8-11 and 25-49 are pending in the application. Claims 28 and 35-48 have been withdrawn from consideration. Reconsideration and allowance of the above referenced application is respectfully requested.

Renewed Response to Restriction Requirement

The Examiner has made final the restriction requirement, requiring restriction between the claims of Group I (claims 3-5, 8-11, 25-27, 29-34 and 49), drawn to methods of treatment using a combination of anti-staphylococcal agent and β -lactam antibiotic, and the claims of Group II (claims 28 and 35-48), drawn to methods of treatment using a combination of anti-staphylococcal agent and glycopeptide antibiotic. Applicants continue to traverse this requirement. Applicants respectfully submit that, according to MPEP § 803, a restriction between patentably distinct inventions is proper only where there is a serious burden on the Examiner to examine all of the claims in a single application. This is true even when appropriate reasons exist for a restriction requirement.

In the present application, it is believed that because there is a close relationship between the subject matter of the Group I and Group II claims, there would be no serious burden on the Examiner to examine both sets of claims at this time. Both of the Group I and Group II inventions are directed to methods of treatment using a combination of anti-staphylococcal agent and an antibiotic. As such, there is a close relationship between the subject matter of these two sets of claims. It is respectfully believed that a search directed to the claims of Group I would include a search directed to the claims of Group

II, and vice versa. Thus, there would be no serious burden on the Examiner to examine all of claims 3-5, 8-11, and 25-49 together at this time.

Rejection of Claims Under 35 U.S.C. § 103(a)

Claims 3-5, 8-11, 25-27, 29-34 and 49 have been rejected under 35 U.S.C. § 103(a) for purportedly being obvious over Climo *et al.* (U.S. Patent No. 6,028,051) in view of Polak *et al.* (*Diagn. Microbiol. Infect. Dis.*, 17:265-270 (1993)) and Schaffner *et al.* (*Yale J. of Biol. and Med.*, 39: 215-229 (1967)). For at least the reasons set forth below, withdrawal of this rejection is believed to be in order.

At the time the invention of the application was made, it was under an obligation of assignment in common with that of U.S. Patent No. 6,028,051. Accordingly, the reference is not available to support a rejection for obviousness. 35 U.S.C. § 103(c), MPEP 706.02(l)(1).

In light of these remarks, withdrawal of this rejection under 35 U.S.C. § 103(a) is respectfully requested.

Double Patenting

Claims 3-5, 8-11, 25-27, 29-34 and 49 have been rejected under the judicially created doctrine of obviousness-type double patenting for purportedly being unpatentable over claims 1-10 of U.S. Patent No. 6,569,830. For at least the reasons set forth below, withdrawal of this rejection is believed to be in order.

The present application is a divisional of U.S. Patent No. 6,569,830 (the '830 patent). During prosecution of the '830 patent, a restriction requirement was made, restricting the claims into two groups: Group I, drawn to methods of treating a staphylococcal infection; and Group II, drawn to compositions comprising two

antibiotics. *See* the Official Action mailed on July 6, 1999 (paper no. 4), attached hereto as Exhibit A. According to the Examiner, these two groups of claims were distinct, each from the other, because the inventions of Groups II and I are related as product and process of use, and the product as claimed could be used in a materially different process. In the parent application, the claims of Group II were prosecuted. The present application claims methods of treating staphylococcal infections.

The present double patenting rejection is inconsistent with the previous determination of patentably distinct inventions, and therefore withdrawal of this double patenting rejection is respectfully requested.

CONCLUSION

In light of the above, Applicants believe that this application is now in condition for allowance and therefore requests favorable consideration.

If any points remain in issue which the Examiner feels may be best resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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